

## REMARKS

The Office Action mailed May 30, 2006 has been carefully considered. Within the Office Action Claims 1-3, 9, 16, 17, 23, 26, 31, 35, 45 and 49 have been rejected. The Applicant has amended Claims 16, 45 and 49 and has cancelled Claims 36-44. The Applicant reserves the right to further pursue the cancelled claims in continuation and/or divisional application as well as for appeal purposes. Reconsideration in view of the following remarks is respectfully requested.

### Information Disclosure Statement

The Applicant had previously filed an Information Disclosure Statement (IDS) with the USPTO on May 26, 2006. However, it does not appear that in the present Office Action that the references cited in the IDS were considered. Thus, the Applicant hereby requests acknowledgement of the IDS filed May 26, 2006. A copy of the previously filed IDS is submitted herein along with the present Reply.

### Rejection under 35 U.S.C. § 103

Claims 1, 2, 3, 9, 16, 17, 23, 26, 31, 35, 45, and 49 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,586,859 to Kornbluh et al. (hereinafter Kornbluh) in view of U.S. Patent No. 4,975,616 to Park.

Specifically, the Office Action states that Kornbluh allegedly teaches an apparatus comprising: a housing (Figure 3A, 400); a sensor configured to detect movement of at least a portion of the housing, the sensor configured to output sensor signals associated with the movement; and an electroactive polymer actuator (Figure 3B, 403a) coupled to the housing and configured to output a haptic-feedback force associated with the output sensor signals (col. 26,

lines 1-22), the haptic feedback force being generated by deformation of the EAP (col. 14, lines 11-31). This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

See M.P.E.P. 2141. In addition, the prior art references together must teach each and every element in the claim.

The Applicant respectfully submits that the Kornbluh reference does not qualify as prior art and thus cannot be used in combination with another reference to establish a *prima facie* case of obviousness. U.S. Patent No. 6,586,859 to Kornbluh (hereinafter "Kornbluh patent") has a filing date of April 4, 2001, whereby the Kornbluh patent claims priority to a provisional application (hereinafter "Kornbluh provisional"), Serial No. 60/194,817 which was filed on April 5, 2000. The Applicant has provided a copy of the filed Kornbluh provisional in the accompanying IDS. In contrast, the present application was filed on May 24, 2001, whereby the present application claims a benefit of priority from provisional patent application (hereinafter "Applicant's provisional"), Serial No. 60/206,929 which was filed May 24, 2000. The Applicant has provided a copy of the Applicant's provisional in the accompanying IDS.

Contrary to the Examiner's assertion, the Kornbluh provisional does not disclose at least some of the subject matter recited in independent Claims 1, 16, 26, 31 or 45. In particular, the Kornbluh provisional does not disclose a EAP actuator coupled to the housing and configured to output a haptic-feedback force associated with the output sensor signals. There is no disclosure, hint, teaching or suggestion in the Kornbluh provisional of a haptic sensor which detects touch from a different body portion of the device, whereby the same transducer may then be responsible for actuation, in response to user interaction. (Kornbluh patent, Col 26, Lines. 1-22). In addition, the Kornbluh provisional does not disclose, hint, teach, or suggest a device which may receive time-variant enforced feedback or that a haptic electroactive polymer sensor may be placed on a nose of a stuffed toy that wiggles when it has been touched. (Kornbluh patent, Col 26, Lines. 1-22). Therefore, the subject matter disclosed in Col. 26, Lines 1-22 of the Kornbluh patent was not disclosed in the Kornbluh provisional and does not receive a priority date of April 5, 2000, but instead receives the later April 4, 2001 filing date. Considering that the subject matter recited in Claims 1, 16, 26, 31 and 45 is found in the Applicant's provisional, filed May 24, 2000, the portions discussed above of the Kornbluh Patent do not predate the effective filing date of the present application and cannot be used prior art to establish a *prima facie* case of obviousness. For at least these reasons, the Kornbluh patent cannot be combined with the Park reference to reach the subject matter recited in Claims 1, 16, 26, 31 and 45. Therefore, Claims 1, 16, 26, 31 and 45 are allowable over the Kornbluh patent and Parks.

With respect to dependent Claim 2 in the present application, the Examiner argues that column 25, lines 26-67 in the Kornbluh patent teaches the subject matter recited in Claim 2. However, none of the subject matter disclosed in column 25, lines 26-67 is present in the Kornbluh provisional. Considering that the subject matter in dependent Claim 2 is found in Applicant's provisional, which was filed prior to the filing date of the Kornbluh patent, the

subject matter in column 25, lines 26-67 of the Kornbluh patent does not predate the effective filing date of the present application and cannot be used as prior art to establish a *prima facie* case of obviousness. For at least these reasons, the Kornbluh patent cannot be combined with the Park reference to reach the subject matter recited in Claim 2. Accordingly, Claim 2 is allowable over the Kornbluh patent in view of Parks.

Regarding dependent Claims 9, 23, 35 and 49, the Examiner refers to column 26, lines 1-22 in the Kornbluh patent. However, as stated above, the Kornbluh patent cannot serve as prior art to reject these claims, because the subject matter discussed in column 26, lines 1-22 of the Kornbluh patent is not found in the Kornbluh provisional. Considering that the subject matter in dependent Claims 9, 23, 35 and 49 is found in Applicant's provisional, filed prior to the filing date of the Kornbluh patent, the subject matter in column 26, lines 1-22 of the Kornbluh patent cannot be used as prior art to establish a *prima facie* case of obviousness. For at least these reasons, the Kornbluh patent cannot be combined with the Park reference to reach the subject matter recited in Claims 9, 23, 35 and 49. Accordingly, Claim 9, 23, 35 and 49 are allowable over the Kornbluh patent in view of Parks.

Claims 2, 3, 9, 17, 23, 35 and 49 are also allowable for being dependent on allowable base claims. As stated above, Claims 1, 16, 25, 31 and 45 are allowable over the Kornbluh patent individually or in combination with another reference. Therefore, claims 1-3, 9, 16, 17, 23, 26, 31, 35, 45 and 49 are allowable over Kornbluh and Parks, individually or in combination.

Conclusion

The Applicant submits that the above amendments and arguments place the present application in a condition for allowance. If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is invited to call the undersigned attorney at the number below.

Please charge any additional required fees or credit any overpayment not otherwise credited, to our deposit account no. 50-1698.

Respectfully submitted,  
THELEN REID & PRIEST, LLP.

Dated: 8/29/06

S. Blat  
Suvashis Bhattacharya  
Reg. No. 46,554

Thelen Reid & Priest LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
Tel. (408) 282-1855  
Fax. (408) 287-8040